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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,887	12/31/2001	Justin F. Beckett	1298-001	4370
23485	7590	05/24/2004	EXAMINER	
JINAN GLASGOW			CAPRON, AARON J	
P O BOX 28539			ART UNIT	
RALEIGH, NC 276118539			PAPER NUMBER	

3714

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,887

Applicant(s)

BECKETT, JUSTIN F.

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 3714

DETAILED ACTION

This is a response to the Amendment received on March 5, 2004, in which claims 1-2 and 15 were amended. Claims 1-38 are pending.

Response to Amendment

In the Amendment dated March 5, 2004, claim 11 states that the claim is currently amended. However, there are no underlines or brackets to indicate any amendments to the claim. The Examiner views claim 11 as being the original claim since the proper procedures were not used to notify the office of any amendments to the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/818,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to claim the method or

Art Unit: 3714

device/apparatus broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing commercial viability.

Essentially, the omitted language pertaining to the 'music game' being a trivia game limited the invention and thus by omitting the language, a broader form of invention is claimed which secures broader protection for commercial viability.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 11-19, 21-31, 34 and 37-38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Walker et al. (U.S. Patent No. 5,734,413; hereafter "Walker").

Walker discloses a method of doing business using an on-line knowledge and skill based gaming wherein a multiplicity of users play simultaneously and where revenue is generated based on the number of players who visit the website where the game is hosted and played.

Art Unit: 3714

Claims 1-4, 10-29, 32-34 and 37 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Miles et al. (U.S. Patent No. 6,102,406; hereafter "Miles").

Miles discloses a method of doing business using an on-line knowledge and skill based gaming wherein a multiplicity of users play simultaneously and where revenue is generated based on the number of players who visit the website where the game is hosted and played.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Spaur et al. (U.S. Patent No. 6,196,920; hereafter "Spaur").

Miles discloses a method of doing business using an on-line knowledge and skill based gaming wherein a multiplicity of users play simultaneously and where revenue is generated based on the number of players who visit the website where the game is hosted and played.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Spaur.

Referring to claims 2, 5-7 and 9, Walker discloses an online tournament that involves games of skill and/or knowledge, but does not disclose advertising in order to generate revenue. However, Spaur discloses advertising during the networked game in order to generate revenue

for the host website (abstract). One would be motivated to combine the references in order to generate extra revenue for Walker's tournament website. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the advertising features of Spaur into the online network game tournament of Walker in order to generate revenue for the host website for each and every game.

Referring to claim 8, Walker and Spaur disclose a trivia game wherein the categories include sports, movies, etc (10:42-59), but do not specifically disclose that the trivia game is music-related. However, it is notoriously well known in the art of trivia games that music related questions and answers are asked to the players. One would be motivated to combine music related questions into a trivia game in order to make the game more interesting and challenging. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate music-related questions into the trivia game of Walker and Spaur in order to make the game more interesting and challenging.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of You Don't Know Jack.

Walker discloses a trivia game, but does not disclose the trivia game having audio or visual clips. However, You Don' Know Jack discloses a trivia game that includes audio and visual clips in order to keep the players entertained throughout the game (page 1, 3rd paragraph, lines 1-2 and page 1, 6th paragraph, lines1-5). One would be motivated to combine the references in order to keep the player entertained through various question sequences. Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to incorporate the sound bytes and visual clips of You Don't Know Jack into the trivia game of Walker in order to keep the player entertained and willing to play more.

Response to Arguments

Applicant's arguments filed March 5, 2004 have been fully considered but they are not persuasive.

Applicant's arguments, see page 8, filed March 5, 2004, with respect to independent claim 2 and its dependent claims has been fully considered and is persuasive.

Applicant argues that Walker and Miles fail to teach having a multiplicity of users play simultaneously. However, Walker clearly discloses having a chess tournament so players do not have to travel long distances to play each other in chess (1:10-4:43 and 9:4-24). Applicant and Applicant's council must ask themselves that if two players are playing against each other in an online chess tournament, how these two players are not playing simultaneously. In addition, the claim language is not so limiting to exclude considering the players playing multiple games over the network and that each player playing the particular game is at the same exact state of the game relative to the other players. Further, Miles clearly discloses knowledge and/or skill based games (2:5-8). The players need to locate answers to a question in order to win the game. The more skilled the player is locating the answers, the more likely the player will win the game. Therefore, the claimed invention fails to preclude the invention of either Walker or Miles.

Applicant argues that Miles generating revenue from the sponsorship and advertising that is related to the number of players who visit the website where the game is hosted and/or played. However, Miles discloses that players play a network scavenger hunt game where players play

Art Unit: 3714

the game by accessing other websites from the host page and locating the answers on the accessed page. Hence, the player plays the game on the accessed website. Therefore, the claimed invention fails to preclude the invention of Miles.

Applicant argues that the combination Walker of the Jack reference renders Jack non-functional. However, Walker discloses having a knowledge game tournament and Jack is a knowledge-based game and the combination of Walker and Jack provide a functional game. As stated above, the claim language is not so limiting to exclude that each player playing the particular game is at the same exact state of the game relative to the other players. Therefore, the claimed invention fails to preclude the combination of Walker and Jack.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

A handwritten signature in black ink, appearing to be 'J. Harrison', with a large, stylized initial 'J'.

JESSICA HARRISON
PRIMARY EXAMINER